

REMARKS

By amendments which accompany this response, Claims 1-15¹ have been canceled and replaced with claims 16-27. The amendments essentially have combined claims 1 and 2 into claim 16. Claims 16 and 26 are now the independent claims on which all other claims depend either directly or indirectly.

In the recent most Office action, The Examiner has objected to both the Oath/Declaration, the Specification and claims 2 and 12. Claim 13 was rejected under 35 U.S.C. 112, second paragraph as failing to particularly point out and distinctly claim the invention. Claims 1-4 and 6-13 were rejected under 35 U.S.C. 102(b) as unpatentable over Anderson (5624213). Claim 14 was rejected under 35 U.S.C. 102(b) as unpatentable over Pidgeon (189). Claim 5 was rejected under 35 U.S.C. 103(a) as unpatentable over Anderson in view of Despres (6641338). Claim 15 was rejected under 35 U.S.C. 103(a) as unpatentable over Pidgeon (189).

Applicant herewith submits modifications to the Specification and claims in accordance with suggestions and directions provided by the Examiner which are believed to address each of the objections and rejections raised. Applicant, respectfully, traverses all grounds of rejection to the extent they are applied to the currently pending claims for the reasons which follow as well as explanations for the modifications to the claims and drawings needed to address the objections raised.

Objection to the Oath/Declaration:

¹ The amended claims find antecedent basis and support in the original claims and Specification. The amendments are presented in an effort to address concerns of the Examiner and to more clearly point out and distinctly claim the invention.

A new Oath/Declaration which refers to the present application by serial no. and filing date and corrects the date of filing of the foreign priority application is submitted herewith. Thus, it is believed that this objection is avoided.

Objection to the Specification:

Applicant has amended the Specification at page 6, line 30 to refer to the "threaded member 12". This objection is believed to now be avoided.

Objections to Claims:

Claims 16 and 17, which replaced claims 2-3 have been amended to more clearly define the invention, as outlined below. The Examiner will appreciate that there are now no antecedent issues relating to "the cutting diameter". The claims now refer to "cutting blades" of the first and second hole saws. Similarly, claim 26 which served to replace claim 12 has also been amended to refer to "cutting blades" as defined in new claim 16, rather than "the cutting surface" and "the cutting face". On this basis, the antecedent objections should be removed.

Rejection under 35 U.S.C. 112, second paragraph:

The Examiner had rejected claim 13 as failing to particularly point out and distinctly claiming the invention. Applicant has canceled claim 13 and believe that this rejection is now avoided.

Rejections under 35 U.S.C. 102(b):

Rejection applied to claims 1-4 and 6-13:

In the Office action of September 14, 2007, the Examiner had rejected claims 1-4 and 6-13 under 35 U.S.C. 102(b) as anticipated by Anderson ('213). Applicant traverses this rejection to the extent that the Examiner may view this rejection as

applicable to newly amended claims 16 and the claims that depend therefrom.

Specifically, newly presented claim 16 has been worded in a manner to more clearly reflect the present invention. More particularly, the subject matter of Claim 5 (now cancelled) relating to the second threaded portion being of a stepped down diameter to the first threaded portion, has been incorporated into the new independent claim. As the Examiner as acknowledged in the rejection of claim 5 under 35 U.S.C. 103(a), Anderson ('213) fails to disclose or teach the presence of this specifically claimed element. Applicant would urge that anticipation requires the disclosure, in a single prior art reference, of each element of the claim under consideration. W.L. Gore & Assoc. v. Garlock, Inc. , 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Here, claim 16, and the claims dependent thereon, includes a specific limitation which Anderson ('213) fails to describe or disclose. Thus, with regard to the presently claimed subject matter the reference relied upon fails to disclose every limitation present in the claims and therefore can not reasonably be said to anticipate the claimed invention within the meaning of 35 U.S.C. 102(b).

Thus, applicant submits that claim 16, and the claims that depend therefrom, are novel when compared to the abovementioned citation. Therefore, applicant requests reconsideration and withdrawal of this ground of rejection.

Rejection of claim 14:

At page 4 the Examiner has set forth the basis and reasoning for rejecting claim 14 under 35 U.S.C. 102(b) as being anticipated by Pidgeon ('189).

Applicant would note that newly presented claim 26, which essentially corresponds to canceled claim 14, claims a saw boss wherein "said second threaded

member being of a stepped down diameter to accommodate a hole saw having a threaded bore diameter smaller than the first hole saw;" as well as claiming the use of drive pins whose purpose is to prevent over-tightening of the hole saws on the respective threaded members. Pidgeon does not include, describe or disclose such a feature. Therefore, Pidgeon ('189) can not be said to teach each and every claim limitation of the present claims. As such, noting the case law cited above, it can not be said that Pidgeon ('189) anticipates the presently claimed invention.

For these reasons, applicant requests reconsideration of this ground of rejection and withdrawal of the rejection under 35 U.S.C. 102(b) to the extent it might be regarded as applicable to newly presented claim 26.

Rejections under 35 USC 103(a):

The rejection of claim 5:

At pages 4-5 of the Office action of September 14, 2007, the Examiner has set forth the basis for rejection of claim 5 as being unpatentable over Anderson ('213) when taken in view of Despres (6641338).

As previously noted, the Examiner acknowledges that Anderson ('213) does not teach a hole saw boss having a first and second portions with diameters in a stepped down configuration. However, the Examiner cites Despres ('338) as showing a hole saw boss having a first and second portions with diameters in a stepped down configuration. The Examiner concludes that "it would have been obvious to one of ordinary skill in the art to modify the hole saw boss of Anderson '213 to include a stepped down boss configuration as taught by Despres '338 to accommodate different

sized attachment bore sizes exhibited on commonly constructed hole saws with various cutting diameters.”

Initially, applicant would note that claim 16 which now includes the limitation from claim 5 relating to saw boss wherein “said second threaded member being of a stepped down diameter to accommodate a hole saw having a threaded bore diameter smaller than the first hole saw” requires not only a step down arrangement but also requires that both portions be **threaded**. Neither Anderson or Despres teach or disclose such an arrangement which is threaded to accommodate two separate saw blades. It does not readily appear, therefore that a person skilled in the art would necessarily have arrived at the presently claimed invention, simply by combining the Anderson and the Despres documents. Neither of these patents involve the use of a threaded member of stepped down cross sectional size for accommodating two hole saws of different diameter at any one time in a simple and effective manner. It is indeed this feature which makes the invention useful in the problem specified, that is, enlarging existing holes in a workpiece.

Even though the Despres patent teaches the possibility of mounting differently shaped hole saws to the arbor, it is intended that only one hole saw be fixed thereto at once. The patent appears to relate specifically to a means of removing portions of workpiece from within the hole saw cup after use. This does not appear possible when two hole saws are fitted to the drill at any one time. The Anderson patent does teach the use of two hole saws, however, it does not include the stepped down threaded portion diameter as claimed and is therefore again, irrelevant. On this basis, we submit that none of the patents, when taken alone or in combination, preclude the

present invention of novelty or inventive step.

Furthermore, the Despres patent requires hole saw cups that are manufactured specifically for that product so that they may be lockingly engaged by the front or rear boss of the hole saw arbor holder. The patent discloses a distinct locking mechanism between the hole saw cups and the arbor involving transverse grooves. It is not readily apparent that it would even be possible to modify the device of Anderson using a portion from Despres in a manner likely to provide a working saw boss, and definitely not in a manner to arrive at the claimed invention. Therefore overall, the Despres patent discloses a quite complex and what looks to be an expensive hole saw locking apparatus. In contrast, the hole saw boss of the present invention avoids such complex designs in that it utilizes threaded portions which are sized and configured to accommodate commonly available hole saw threaded bores. In particular, the hole saw boss is able to accommodate hole saw cups which are currently available on the market and configured to be fitted to conventional hole saw bosses. This provides a useful result in that consumers are not required to spend additional money on purpose built hole saw cups.

For these reasons, applicant requests reconsideration of this ground of rejection and withdrawal of this rejection to the extent it may be regarded as applicable to the newly submitted claims.

Rejection of claim 15:

At page 5 of the Office action of September 14, 2007, the Examiner has set forth the reasoning and basis for rejecting claim 15 under 35 U.S.C. 103(a) as unpatentable over Pidgeon. Newly presented claim 27 would appear drawn to the subject matter

previously covered by claim 15. Therefore, the following remarks are directed to the patentability of claim 27. The Examiner acknowledges that Pidgeon ('189) fails to disclose a device wherein the drive pins are of a magnetized material. However, the Examiner urges that "It would have been obvious to one having ordinary skill in the art at the time of the invention was made to manufacture the drive pins from any magnetized material composition for the purpose of improving the driving contact area between two parts and/or to eliminate loss of the driving pins during assembly/disassembly, because it has been held to be within the general skill of a worker in the art to select a (known finishing method or known material composition) on the basis of its suitability (in producing a known finishing surface or for the intended use as a matter of obvious design choice.

Initially, applicant would note that claim 27 depends indirectly on claim 16 which requires as one of the elements of the claimed saw boss that it include "said second threaded member being of a stepped down diameter to accommodate a hole saw having a threaded bore diameter smaller than the first hole saw." As noted above, Pidgeon does not disclose or suggest this aspect of the claimed invention. Thus, one would have to modify Pidgeon more extensively than making the one drive pin of a magnetic composition.

Further, the Examiner has provided no evidence that such a magnetic composition has ever been used in a drive pin of a saw boss in the manner required by claim 27. To the extent that the Examiner urges that such a substitution would have been obvious, applicant would note that it can not have been obvious to substitute from the unknown into the known. The Examiner is clearly using applicant's

disclosure of the invention as a basis for suggesting the modification of the device of Pidgeon. This is not a situation of designer choice since the element has not been shown to be old in the prior art and therefore available as a possible choice in this type of device. The only thing that suggests the use of a magnetic substance or composition for the drive pin, is applicant's disclosure. It is clearly established in the case law relating to obviousness rejections that such information, derived from applicants disclosure of their invention, can not be used to establish that the invention is obvious within the meaning of 35 U.S.C. 103(a). The use of such information would constitute impermissible hindsight reconstruction. In other words, "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). "[T]here still must be evidence that 'a skilled artisan, . . . with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.'" Echolochem. Inc. v. Southern California Edison, 227 F.3d 1361, 1375, 56 USPQ2d 1065, 1075-76 (Fed. Cir. 2000). Such evidence is missing in the instant rejection. There is nothing in this record which would readily suggest the modification of the Pidgeon device in a manner which would have led to the invention of claim 27.

Therefore, for the reasons set forth here and above, applicant would urge reconsideration of this ground of rejection and the withdrawal of this ground of rejection under 35 U.S.C. 103(a).

Conclusion

In conclusion, applicant has presented arguments and amendments relating to

both the grounds of objection and the grounds of rejection set forth in the Office action of September 14, 2007. Applicant, respectfully, requests that the Examiner reconsider these objections and rejections and find all claims allowable.

Should any official at the United States Patent and Trademark Office deem that any further action by the Applicant or Applicant's undersigned representative is desirable and/or necessary, the official is invited to telephone the undersigned at the number set forth below.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 CFR §§ 1.16-1.17 or credit any overpayment, to deposit account No. 503321. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, or otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 503321.

Respectfully submitted,

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